

Attorney Docket No. IBM/116
Confirmation No. 9216



PATENT

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Cary Lee Bates, Paul Reuben Day, John Matthew Santosuosso

Appeal No. _____
Application No. 09/491,902

REPLY BRIEF

PATENT



IBM/116
Confirmation No. 9216

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cary Lee Bates et al. Art Unit: 2641
Serial No.: 09/491,902 Examiner: Daniel Demelash Abebe
Filed: January 27, 2000 Atty. Docket No.: IBM/116
For: AUTOMATED DETECTION OF SPOKEN NUMBERS IN VOICE MESSAGES

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

This paper is submitted in reply to the Examiner's Answer dated November 24, 2003, within the two month period for response. Consideration of the additional remarks presented below, and reversal of all of the Examiner's rejections, are respectfully requested.

First, Applicants respectfully traverse the Examiner's grouping of claims made in Section (7) of the Examiner's Answer. The Examiner attempts to group together all of the claims subject to each rejection, arguing that the Examiner does not agree with Applicants' statement that certain claims do not stand or fall together. In support of this grouping, the Examiner argues that claims 10-11, 22-23, and 27 recite a "similar step" for recognizing and auto-dialing a phone number, and that claims 1-6, 8-9, 13-16, 18-21, and 25-26 recite playing a voice message by starting with a telephone number.

While the Examiner is somewhat correct in characterizing the common recitations in these groups of claims, by attempting to group the claims in this manner, the Examiner is apparently attempting to avoid having to address any of the dependent claims in these groups that have been separately argued by Applicants. Certainly, applicants are of the opinion that all of the claims in each group are patentable by virtue of the unique features recited in the independent claims. However, the whole point of arguing some of the dependent claims separately is to address the additional features in those claims that impart additional reasons for patentability to those claims.

It is Applicants' understanding, from 37 C.F.R. 1.192(c)(7) and M.P.E.P. Section 1206, that an Appellant is required to state that claims do not stand or fall together, and to present arguments why claims subject to the same rejection are separately patentable. Once that is done, the Board decides the Appeal as to each ground of rejection separately for those claims the Appellant has indicated to be separately patentable.

Applicants have complied with this requirement by indicating in the arguments why the limitations in various claims, such as claims 4-5, 9, 13, 21, and 25, are separately patentable from the other claims subject to the same rejection. The Examiner on the other hand has failed to address why these additional limitations are not considered to render the claims separately patentable, and has also failed to rebut Applicants' arguments for patentability for those claims. Accordingly, Applicants respectfully submit that the Examiner's suggested grouping of claims is not appropriate, and should not be followed by the Board.

Second, Applicants wish to point out that the Examiner continues to misquote the *Lee* reference in support of the Examiner's arguments. In particular, the Examiner supposedly quotes column 2, lines 42-47 of *Lee* as stating "prior/before to replaying the (rest) of the messages to the called party" at page 4 of the Examiner's Answer. As discussed at page 7 of Applicants' Brief, however, the correct version of the passage is "before replaying the message to the called party." The subtle change made to the disclosure in *Lee* completely alters the overall impression of the passage in favor of the Examiner's argument. When read in context with the rest of the disclosure of *Lee*, however, it is readily apparent that *Lee* teaches only the display of a spoken number or recitation of the spoken number by a voice synthesizer prior to playing a voice message from the beginning. By altering the quote, the Examiner attempts to argue that *Lee* teaches starting the playback of a voice message near a spoken number. Applicants submit, however, that the actual quote does not support this reading.

Third, one passage relied upon by the Examiner (discussed at page 5 of the Examiner's Answer), at column 4, lines 62-67 of *Lee*, appears to be misinterpreted by the Examiner. The cited passage recites that the "information in the message table provides microprocessor 28 with the start and end addresses of the verbal message and phone number stored in recorder 12 and memory 18, respectively." The Examiner apparently argues that this passage supports the Examiner's argument that *Lee* discloses that during playback, the position of a telephone number

a telephone number is identified and judged to be the starting position. A reading of this passage in context with the rest of *Lee*, however, does not support this interpretation.

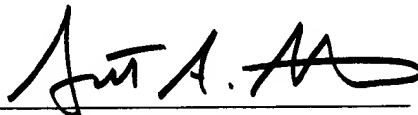
In particular, Fig. 2, and the accompanying disclosure at column 3, lines 12-34 makes it clear that the "address" of the phone number for a particular message relates to an address within a memory, and not within a voice message. Column 3, lines 22-37 of *Lee*, for example, disclose that the "voice address" column in Fig. 2 stores beginning and end addresses for a voice message in a recorder 12. Continuing at column 3, lines 27-34, *Lee* discloses that the "phone number address" column in Fig. 2 keeps track of beginning and end addresses of a phone number within a memory 18, which as can be seen from Fig. 1, is separate from recorder 12. *Lee* also discloses, at column 2, lines 19-34, that the telephone number stored in memory 18 is stored in a textual format after being processed by a recognizer 16. Therefore, it should be readily apparent that the starting and ending addresses stored for a particular telephone number in column 4 of Fig. 2 have no relation to the location of the telephone number within a voice message.

As such, Applicants respectfully submit that the addresses stored in the table of Fig. 2 for each phone number are incapable of being used to determine a playback start position for a voice message.

In misinterpreting the disclosure of *Lee* in this manner, the Examiner imparts to *Lee* teachings that are well beyond that which would be appreciated by one of ordinary skill in the art. Accordingly, Applicants respectfully submit that, under a proper interpretation of *Lee*, there is no clear anticipation of Applicants' claims by *Lee*.

Reversal of the Examiner's rejections, and allowance of all claims, are therefore, respectfully requested. If there are any questions regarding the foregoing, please contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,



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20 JAN 2004

Date